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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/575,473

04/12/2006

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KAWA3206

3226

23364 7590 03/20/2008

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EXAMINER

LAMM, MARINA

ART UNIT

PAPER NUMBER

1617

MAIL DATE

DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/575,473	<b>Applicant(s)</b> KAWASAKI, KIWAMU	
	<b>Examiner</b> MARINA LAMM	<b>Art Unit</b> 1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) 5-13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____.                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____.  | 6) <input type="checkbox"/> Other: ____.                          |

### **DETAILED ACTION**

Acknowledgment is made of the amendment filed 12/18/07. Claims pending 1-13. Claims 5-13 have been added.

### ***Election/Restrictions***

1. Newly submitted claims 5-13 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The original claims and the newly added claims are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case the product of Claims 1-4 can be used as an antibacterial composition as evidenced by the cited prior art reference.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 5-13 have been withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set of rejections and/or objections presently being applied in the instant application.

***Claim Rejections - 35 USC § 103***

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 2002308783 A (English Abstract), cited by the Applicant.

JP 2002308783 A teaches a pharmaceutical composition comprising an aqueous solution containing sodium, potassium, calcium, magnesium, chlorine and bicarbonate ions at total concentration of 0.54 mol/l or less and a saccharide such as glucose, at a concentration of 0.07-0.25 mol/l. The compositions of JP 2002308783 A can contain sodium glutamate and are useful for the treatment of atopic dermatitis, inflammation and skin itching. See Abstract. The Abstract does not explicitly teach the claimed molar concentration proportion of the ions and the claimed concentration of sodium glutamate. However, determination of optimal or workable molar concentration proportion of the ions as well as concentration of sodium glutamate by routine experimentation is obvious absent showing of criticality of the claimed proportion and concentration. One having ordinary skill in the art would have been motivated to do this to obtain the desired anti-inflammatory, anti-allergic and antibacterial properties of the composition. The Courts have long held that proportions of ingredients, to impart

patentability to an otherwise obvious chemical composition, must produce more than a mere difference in degree in the properties of the composition. *In re Fields* (CCPA 1962) 304 F2d 691, 134 USPQ 242. The proportions must be critical, i.e., they must produce a difference in kind rather than degree. *In re Touvay et al.* (CCPA 1958) 264 F2d 901, 121 USPQ 265; *In re Selmi et al.* (CCPA 1946) 156 F2d 96, 70 USPQ 197; *In re Waite* (CCPA 1948) 168 F2d 104, 77 USPQ 586.

Therefore, the invention as a whole would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made.

### ***Response to Arguments***

4. Applicant's arguments filed 12/18/07 have been fully considered but they are not persuasive.

The Applicant argues: "The Japanese application is directed at a pharmaceutical composition for preventing and treating certain skin diseases, regulating the intestines, healing pharyngitis or stomatitis, for a bacteriostatic bath, for suppressing fungal infection and for protection of a wound from infection. On the other hand, the instantly claimed compositions are cosmetic compositions not pharmaceutical or curative compositions. It is submitted that the preamble "cosmetic" provides a difference in kind and breathes life and meaning into the claims 1-4." See p. 5 of the reply. In response, the recitation of intended use, i.e. "cosmetic", is not given any patentable weight. The courts have held that in composition claims "intended use must result in a structural difference between the claimed invention and the prior art in order to patentably

distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim." See *In re Casey*, 152 USPQ 235 (CCPA 1967); *In re Otto*, 136 USPQ 458, 459 (CCPA 1963)

### ***Conclusion***

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marina Lamm whose telephone number is (571) 272-0618. The examiner can normally be reached on Mon-Fri from 11am to 7pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan, can be reached at (571) 272-0629.

Art Unit: 1617

The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Marina Lamm/  
Examiner, Art Unit 1617  
3/6/08

/SREENI PADMANABHAN/

Supervisory Patent Examiner, Art Unit 1617